

Sarda, Germaine S.

From: Sarda, Germaine S.
Sent: Friday, March 07, 2008 3:39 PM
To: 'lionelscott@btinternet.com'
Cc: 'Gerard Bencen'; Murashige, Kate H.
Subject: Our Reference: 61629-20001.30

Attachments: Document.pdf



Document.pdf (391
KB)

Re: Inventorship Issues Raised
Our Reference: 61629-20001.30

Dear Dr. Scott,

Attached please find a letter from Kate Murashige for the above-referenced matter.

Please let me know if I may be of further assistance to you.

Best regards,

Germaine Sarda
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March 5, 2008

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Via E-mail: lionelscott@btinternet.com ONLY

Dr. Lionel Scott
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Re: Inventorship Issues Raised
Our Reference: 61629-20001.30

Dear Dr. Scott:

This is a follow-up letter to the one I sent earlier concerning the above-referenced matter. I wanted to get the appropriate materials to you quickly for your consideration, but I thought it might be helpful to amplify on the conclusion that any contribution you might have made to the invention described in the application filed on behalf of Baulcombe and Hamilton, originally as GB 99/25459 must, in any event, be assigned to PBL.

Section 39 of the Patent Act governs rights to employees inventions. The section concerns two situations under subparagraph (1) and subparagraph (2). Subparagraph (1) relates to your situation; subparagraph (2) relates to whatever does not fit into subparagraph (1).

Subparagraph (1) describes inventions that belong to the employer. The conditions under which this is the case are

- (a) that the invention was made in the course of the normal duties of the employee or other assigned duties and where the invention might reasonably be expected to result from carrying out these duties; or
- (b) where, at the time of making the invention, the nature of the duties are such that the employee has a special obligation to further the interests of the employer's undertaking.

I did not quote this verbatim, of course, since you have a copy of this section of the statute.

Dr. Lionel Scott

March 5, 2008

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Your situation fits Section 39(1)(1) because what you describe as assertedly your invention in your original letter seems to have arisen in the course of your duties and would reasonably be expected to result therefrom. For example, Schedule 1 attached to your employment agreement states that: among other things, you are supposed to identify intellectual property rights arising out of work done at the research institutions that the company serves or has dealings with which may be capable of adoption, protection and commercial exploitation and take all reasonable steps to secure rights in and maintain best possible protection of intellectual property adopted by the company (Item 1(d) and (e)).

Alternatively, fitting § 39(1)(b), the invention was made in the course of your duties and you had a special obligation to further the interests of the employer's undertaking. That seems to be described by the foregoing as well.

While there is no question in my mind that any invention you might have made in the course of your duties as Patent Manager, regardless of what it is, would be under obligation of assignment to PBL, this does not address the question of whether you would be properly part of the inventive entity with respect to any claims in applications derived from GB 99/25459.

We are, of course, under obligation to assure that the inventorship of any patents to issue from applications based on this original British application is correct. I understand the points that you made in your original letter to me and believe that any contribution you might have made to "scope out" the disclosure of the named inventors, even assuming this to be accurate, would fall within the ordinary responsibilities of a patent professional responsible for obtaining the best possible patent protection.

We would definitely like to resolve this in a non-adversarial way, and request that you objectively consider our position in this matter.

Best regards,



Kate H. Murashige

KHM:cs

cc: Gerard Bencen M.S., J.D. (via e-mail)